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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/786,343 | 02/25/2004 | Michael Tepoe Nash | M. NASH | 3834 |

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| EXAMINER |
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RUSSELL, CHRISTINA MARIE

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| ART UNIT | PAPER NUMBER |
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2837

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
|--|------------|---------------|
| 3 MONTHS | 04/25/2007 | PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/786,343

Applicant(s)

NASH, MICHAEL TEPOE

Examiner

Christina Russell

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5-14 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 5-14 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims ⁵⁻¹⁴~~1-14~~ are rejected under 35 U.S.C. 103(a) as being unpatentable over the US patent to Breitweiser, Jr. et al. (5,408,914), in view of the US patent application publication to Sitrick et al. ((US 2003/0110926).

3. In terms of claim 5, Breitweiser et al. teaches of a stringed musical instrument, as seen in Figure 2, which comprises a body, a neck, and a plurality of strings positioned lengthwise about the neck. Breitweiser et al. also teaches a computer or microprocessor mounted in the body of the instrument, being visible to the user, and displaying information and instructions to aid the user in playing the instrument (see Figure 6, column 2, lines 44-56, column 3, lines 3-17 and 63-68, column 4, lines 23-27 and 42-55, and column 5, lines 34-60). Breitweiser et al. does not however teach specifically of the unit comprising an operating system. Sitrick et al. teaches of an operating system, which allows the user to create or input, store in memory, recall, or retrieve from memory, and manage, or edit, music related and as will be seen in claim 12, non-music related data (see page 3, end of paragraph [0045] and paragraph [0046], page 4,

paragraph [0052], page 6, paragraph [0065], page 7, paragraph [0069], page 8, paragraph [0080], page 9, paragraph [0087], page 12, paragraph [0107], and page 13, paragraph [0124]). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention to use the standard computer and imaging techniques presented by Sitrick et al. in the computer unit positioned in the body of the stringed instrument shown by Breitweiser et al. The microprocessor taught by Sitrick et al. allows for construction to be made on a chip to fit in a desired location, such as the body of an instrument, and further teaches the ability to provide this chip with custom logic to fit the users preferences.

4. As for claims 6 and 7, dependent upon claim 5, Breitweiser et al. and Sitrick et al. teach all the above claimed elements of claim 5, and Breitweiser further teaches the stringed musical instrument as a guitar, or a variation there of (see references from claim 5, and column 6, lines 46-51). Therefore, obvious stands for the reasons stated above.

5. As for claim 8, Breitweiser et al. teaches his microprocessor, or computer unit integrated into the body of the instrument as can be seen in the references of claim 5 (see also column 4, lines 1-6). Therefore, obviousness stands.

6. As for claims 9-14, Breitweiser et al. and Sitrick et al. teach all the above claimed elements of claim 5, which claims 9- 14 depend on, and Sitrick et al. further teaches of a standard microprocessor which can be placed in any computer system, which comprises component hardware and supporting software, in a handheld embodiment

(see paragraphs [0062] and [0065]). Therefore, obviousness stands for the reasons stated in claim 5.

7. More specifically, as seen in claims 9 and 10, Sitrick et al. teaches of menu driven software as being part of the standard computer components, and also of the ability to provide a touch sensitive display screen (see paragraphs [0012], [0045], [0046], and [0106]).

8. As for claim 11, Sitrick et al. teaches of the compatibility of his microprocessor with a DVD player, or digital video disc player (see paragraph [0060]).

9. As for claim 12, Sitrick et al. teaches the use of PDA software (see paragraph [0065]), which is commercially known to have custom application software, which allows the user to store and display contact names and addresses in an electronic address book format.

10. As for claim 13, Sitrick et al. teaches the addition of a USB port to the computer unit to give the user access to downloaded material, which is also considered well known in the art of computers (see paragraphs [0045] and [0063]).

11. As for claim 14, Sitrick et al. further teaches a display, as seen in the Breitweiser reference, which has the ability to display song scores or tablature (see paragraphs [0012], [0046], [0048], and [0106]).

Response to Arguments

12. Applicant's arguments filed 3/1/2007 have been fully considered but they are not persuasive.

13. Applicants first, and main argument, states that a music stand and a musical instrument are non-analogous art. Applicant further argues in support of this assertion that both references are related to music and that they are combinable for the purposes of recording music (see Applicant's own remarks, bottom of page 7 and top of page 8). This argument is not persuasive. The applicant's assertions make it unclear what he would regard as analogous art. Rather, applicant's arguments seem to support the position that the two references are analogous art. As applicant points out both are related to the endeavor of music and they are regularly combinable in pursuit of making music. Sitrick et al. further demonstrates this combination by allowing the connection of the invention to a musical instrument or music device (see paragraphs [0010], [0051], and [0052]).

14. The applicant is entitled to the opinion that the two references are unrelated and are non-analogous art. However, applicant's opinions do not carry the weight of law. The legal standard for determining whether two references are analogous art is whether or not one of *ordinary* skill in the art would be inclined to look at said references. Perhaps the disagreement lies in what applicant regards as one of ordinary skill in the art. If the applicant regards one of ordinary skill in the art to be a musician who plays the instrument than said individual would be most inclined to look at the equipment that

person is using. In this regard it is hard to conceive of more analogous art than two devices that are intended to connect to one another (see Sitrick et al. paragraphs [0010], [0051], and [0052]). If applicant regards one of ordinary skill in the art to be an engineer attempting to render an improvement to Breitweiser et al.'s device, than one skilled in the art would be most inclined to search references related to musical instruments and computer systems, such as the computer system taught by Sitrick et al. If applicant regards one of ordinary skill in the art as a person familiar with the patent system, be it an attorney or a judge, that person would be most inclined to look in the same classification, class 84 subclass 477R, where both Breitweiser et al. and Sitrick et al. reside.

15. The Applicant further argues the use of the Sitrick et al. operating system in the Breitweiser et al. invention. The Applicant claims that it cannot be incorporated into the musical instrument of Breitweiser et al, and that there is no indication that the operating system can be removed. The Examiner disagrees. To start, the Examiner has pointed out that the system of Sitrick et al. can be made on a chip to fit a desired location. However, if the Applicant would like to refer to the operating system alone, it can be stated that an operating system is an abstract concept, therefore there is no need for physical removal, and it can be inherently incorporated into any computer by the very nature of it being a computer system. Breitweiser et al. as stated above, teaches a computer or microprocessor, which performs functions or processes, and therefore inherently has an operating system of its own. The Examiner is merely incorporating the

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functionality of the operating system as presented by Sitrick et al. into the already present operating system and computer system of Breitweiser et al.

16. The Applicant further argues that there is no indication that any part of Sitrick et al. can be used to play music. Again, the Sitrick et al. reference is being used for additional functionality purposes and not for music playing abilities, the Breitweiser et al. reference covers that aspect. Further, the claims do not specifically state that the invention must play music, only that the operating system must provide for the creation (which isn't necessarily an audio output), storing, recalling and managing of data.

17. The Applicant argues that Sitrick et al. does not approach the portability of the computer unit in combination with the stringed instrument as claimed. First, it has been shown in the Sitrick et al. reference that the invention can be made portable (see paragraph [0065]), therefore, if a user wanted to incorporate all functions of Sitrick et al. into the invention of Breitweiser et al they could. Also, it has been held that making an old device portable or movable without producing any new and unexpected result involves only routine skill in the art. In re Lindberg, 93 USPQ 23 (CCPA 1952). Further it has be discussed above that the main aspect of Sitrick that is to be incorporated into Breitweiser et al. is the functionality of the operating system, which the Examiner has thoroughly shown to be an obvious combination.

Conclusion

18. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

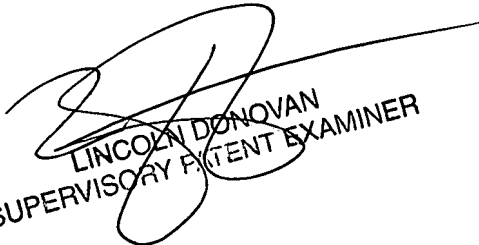
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christina Russell whose telephone number is 571-272-4350. The examiner can normally be reached on Mon-Fri, 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lincoln Donovan can be reached on 571-272-1988. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

CR
4/20/2007


LINCOLN DONOVAN
SUPERVISORY PATENT EXAMINER